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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,243

04/14/2005

Ehud Katzenelson

29413

6516

7590 01/28/2008  
Martin Moynihan  
Anthony Castorina  
Suite 207  
2001 Jefferson Davis Highway  
Arlington, VA 22202

EXAMINER

SHRIVASTAV, BRIJ B

ART UNIT

PAPER NUMBER

2859

MAIL DATE

DELIVERY MODE

01/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/531,243	Applicant(s) KATZENELSON ET AL.	
	Examiner Brij B. Shrivastav	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-199 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-199 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, drawn to a method of designing a magnetic resonance structure for providing a monotonic static magnetic field for magnetic resonance analysis, classified in class 335, subclass 216.
  - II. Claims 11-34 and 78-82, drawn to a magnetic structure for magnetic resonance analysis, classified in class 324, subclass 319
  - III. Claims 35-77, drawn to an apparatus for magnetic resonance analysis, classified in class 324, subclass 307.
  - IV. Claims 83-147 and 148-199, drawn to a system for analyzing an object, classified in class 600, subclass 410+.
2. Inventions I and II, I and III, and I and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process could be used to make imaging apparatus which could be used either of the above stated invention.
3. Inventions II and III, II and IV, and III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other

combinations (MPEP § 806.05(c)). In the instant case, each of the subcombination has separate utility such as the subcombination could be used in class 600/410+ in a medical diagnostic device or either in each of the class 324/307 or 324/319 as stated above, or in class 324/303 in a well logging device.

4. The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

If group II is elected, a further election of species is required. These species are as follows:

- A1. Claim 14 directed to the magnetic structure utilizing predetermined geometry, selected from the group having various shapes;
- A2. Claims 32-34, directed to the magnetic structure, wherein the predetermined geometry is a shell having a cavity and a symmetric axis;
- A3. Claims 15-22, directed to the magnetic structure, wherein the predetermined geometry is elongated with respect to a longitudinal axis;
- A4. Claims 12, 13 and 23-27, directed to the magnetic structure, including magnetic and non-magnetic domains;
- A5. Claims 28-31, directed to the magnetic structure, wherein the predetermined geometry is characterized by at least one substantially planar surface defined by a perpendicular to the planar surface axis.

The species are distinct because they have a materially different design or mode of operation and are mutually exclusive;

- A6. Claims 79-82, directed to the magnetic structure for magnetic resonance analysis, wherein the first and second geometries are selected to maximize magnetic field query above a determined threshold.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merit to which claims shall be restricted if no generic claim is finally held to be allowable. Currently no claim is deemed generic.

7. If group III is elected, a further election of species is required. These species are as follows:

B1. Claims 36-47, directed to an apparatus for magnetic resonance analysis, wherein the gradient coils and the radiofrequency coil are arranged in various ways along with a versatile detachable/replaceable magnetic structure;

B2. Claims 50 and 68-70, directed to an apparatus for magnetic resonance analysis, wherein the predetermined geometry is selected from various shapes including various shells;

B3. Claims 51-58 and 64-67, directed to an apparatus for magnetic resonance analysis, wherein the predetermined geometry is characterized by a planer surface(s), and is elongated along a longitudinal to be used for endoscopy;

B4. Claims 48, 49 and 59-63, directed to an apparatus for magnetic resonance analysis, having multiple magnetic and non-magnetic domains;

B5. Claims 71-77, directed to an apparatus for magnetic resonance analysis, magnetic structure and radiofrequency coil are miniaturized to be swallowed for image normal and pathological tissue to obtain dynamic resonance characteristics.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merit to which claims shall be restricted if no generic claim is finally held to be allowable. Currently no claim is deemed generic.

8. If group IV is elected, a further election of species is required. These species are as follows:

- C1. Claims directed to figure 2;
- C2. Claims directed to figure 3;
- C3. Claims directed to figure 4;
- C4. Claims directed to figure 5;
- C5. Claims directed to figure 6;
- C6. Claims directed to figure 9;
- C7. Claims directed to figure 10.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merit to which claims shall be restricted if no generic claim is finally held to be allowable. Currently no claim is deemed generic.

- 9. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species MPEP 809.02(a).

10. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or with traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction, the election shall be treated as an election without traverse.

11. Should applicant traverse on the ground that the invention or species are not patentably distinct, applicant should evidence or identify such evidence now of record showing the invention or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. A telephone call was made to Attorney Martin Moynihan on January 18, 2008 to request an oral election to the above restriction requirement, but did not result in an election being made.

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim



remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brij B. Shrivastav whose telephone number is 571-272-2250. The examiner can normally be reached on 7 AM to 4 PM.

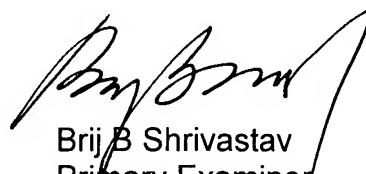
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Dean Reichard can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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January 18, 2008



Brij B Shrivastav  
Primary Examiner  
Art Unit 2859